

REMARKS

In response to the above-identified Office Action (“Action”), Applicants traverse the Examiner’s rejection of the claims and seek reconsideration thereof. Claims 1-19 are pending in the present application. In the instant Action, claims 1 and 10-19 are rejected and claims 2-9 are objected to. In this response, claims 1, 10 and 19 are amended, no claims are cancelled and no claims are added.

I. Claim Amendments

Applicants respectfully submit herewith amendments to claims 1, 10 and 19. Specifically, claims 1, 10 and 19 are amended to delete the recitation of “(i.e., a root of a nearby node’s tree).”

Applicants respectfully submit the amendments do not add new matter and are supported by the specification. Accordingly, Applicants respectfully request consideration and entry of the amendments to claims 1, 10 and 19.

II. Claim Objections

In the outstanding Action, the Examiner objects to claims 1-19 because of informalities. In particular, the Examiner indicates it is unclear whether the phrase “(i.e., a root of a nearby node’s tree)” is part of the claimed invention. As previously discussed, claims 1, 10 and 19 have been amended to delete this phrase. Applicants believe the amendments to claims 1, 10 and 19 overcome the objections with respect to claims 1-19. Accordingly, reconsideration and withdrawal of the objection to claims 1-19 is respectfully requested.

III. Claim Rejections – 35 U.S.C. §112

In the outstanding Action, claims 10-18 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner alleges the specification fails to disclose an intermediate node being set as a root for one tree with paths leading to start and destination nodes as recited in claim 10. Applicants respectfully traverse the rejection as follows.

Applicants respectfully submit the test for enablement is whether the application, when filed, contained sufficient information regarding the subject matter of the claims to enable one skilled in the pertinent art to make and use the claimed invention without undue experimentation. Applicants believe upon review of the instant application and in particular, Figure 4, one of ordinary skill in the art would understand how to make and use the method of claim 10 including an intermediate node being set as a root for one tree with paths leading to start and destination nodes without undue experimentation. In particular, node “e” illustrated in step 409 of Figure 4 provides an exemplary intermediate node set as a root. Step 409 of Figure 4 further illustrates a path from the intermediate node (e) to the start node (e-s) and from the intermediate node to the destination node (e-f-d). Applicants believe the foregoing disclosure provides sufficient enablement for claim 10. Thus, for at least the foregoing reasons, claim 10 and its dependent claims 11-18 are in compliance with 35 U.S.C. §112, first paragraph. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 10-18 on this basis.

IV. Claim Rejections – 35 U.S.C. §102

In the outstanding Action, claims 1 and 19 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,879,564 issued to Parham et al. (“Parham”). Applicants respectfully traverse the rejections as follows.

Applicants respectfully submit Parham fails to teach at least the elements of “including nodes close to the start node in a first node group, and including nodes close to the destination node in a second node group” as recited in step (b), “selecting a node having a minimum cost associated with the roots from among a plurality of nodes contained in the first and second node groups” as recited in step (c) and “repeatedly performing a process from the step (c) when the node is found in the first and second node groups” as recited in step (f) of claims 1 and 19.

Parham generally discloses a method for designing communication paths in a computer network for transmission of data throughout the network. The Examiner alleges servers A-E illustrated in Figure 4a of Parham are roots of trees and C and E are start and destination root nodes, respectively. The Examiner further characterizes server I close to the alleged start node C as a first node group and server J close to the destination node E as a second node group. Step

(b) of claims 1 and 19, however, require that the node groups be formed by nodes close to the start node or destination node. Step (c) further recites a plurality of nodes contained in the first and second node groups. Accordingly, there must be more than one node (not including the root node) in the groups to choose from. Since the groups relied upon by the Examiner only include a single node (I or J), they may not be characterized as first and second node groups. Moreover, Parham discloses that once the servers (e.g. I and J) are grouped with their respective roots (e.g. C and E) they are not grouped with any other roots. See Parham, col. 5, lines 16-19. Thus, according to Parham a selected node, for example, server I, may not be found in both the alleged first node group including server I and second node group including server J. In the absence of such a configuration, step (f), which recites repeatedly performing step (c) when a node is found in the first and second node groups may not be taught by the reference. Thus, the Examiner has not identified a portion of Parham disclosing at least these elements of claims 1 and 19. Since the reference fails to teach each and every element of the claims, anticipation may not be established with respect to claims 1 and 19. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1 and 19 under 35 U.S.C. §102 over Parham.

In regard to dependent claims 2-9, these claims depend from claim 1 and incorporate the limitations thereof. Thus, for at least the reasons that claim 1 is not anticipated by Parham, claims 2-9 are further not anticipated by Parham. Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2-9 under 35 U.S.C. §102 over Parham.

In addition, although Parham is not cited as a basis for rejecting claims 10-17 in the instant Action, Applicants respectfully submit claims 10-17 are further not anticipated by the cited art at least for the reasons previously discussed.

V. Allowable Subject Matter

Applicants respectfully acknowledge with appreciation the Examiner's indication that claims 2-9 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 2-9 depend from claim 1 and incorporate the limitations thereof. As previously discussed, claim 1 is not anticipated by the prior art. Thus, for at least the reasons that claims 2-9 depend from an allowable base claim, Applicants believe

claims 2-9 are patentable over the cited art without rewriting the claims in the manner proposed by the Examiner. Accordingly, Applicants respectfully request consideration and allowance of claims 2-9 at the Examiner's earliest convenience.

CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-19, are now in condition for allowance and such action is earnestly solicited at the earliest possible date. If there are any additional fees due in connection with the filing of this response, please charge those fees to our Deposit Account No. 02-2666. Questions regarding this matter should be directed to the undersigned at (310) 207-3800.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web to the United States Patent and Trademark Office on July 19, 2007.

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